

In the Office Action, claims 1, 3-5, 9-12, 14, 15, 18, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,901,224 to Hecht (hereafter “Hecht”), further in view of U.S. patent 6,400,392 to Yamaguchi et al. (hereafter “Yamaguchi”). Claims 6-8, 16, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hecht, further in view of U.S. patent 5,444,779 to Daniele (hereafter “Daniele”). Claims 13 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hecht. Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hecht, further in view of U.S. patent 6,253,184 to Ruppert (hereafter “Ruppert”). Applicants respectfully traverse these rejections for at least the following reasons.

#### Independent Claims 1 and 20

With respect to independent claims 1 and 20, each of these claims recite an electronic document encoding and processing method (or system) in which hardcopy image capture is activated by waving a copy of the hardcopy document in front of the image capture device. This feature provides several advantages such that the document encoded with a mark may be processed expediently by activating the image capture device automatically. As acknowledged in the Office Action, Hecht does not disclose or suggest an activation of the image capture device in an electronic document encoding and processing method.

Neither is this deficiency cured by the newly cited Yamaguchi reference for at least the following reasons. *First*, Yamaguchi does not relate to a reprographic system (for documents) as alleged in the Office Action. See page 4, lines 6 of the Office Action. Rather, Yamaguchi is directed to a *video information* adjusting apparatus (together with receiving and transmitting video information) such as that used in videotelephones or video conferencing systems. See, e.g., col. 1, lines 7-18 of Yamaguchi.

*Second*, this different videoconferencing device disclosed by Yamaguchi is significant because the cited portions in the Office Action (and the remaining disclosure in Yamaguchi) is not directed at activation by waving a document but rather follows the movement of a hand or senses the presence of a user (for example, a participant in the videoconference) to determine which document that user may be pointing or referring to. See Figs. 14-27 and its discussion in the text of the Yamaguchi patent. That is, waving of the document by itself is

not a significant event in Yamaguchi's video information adjustment system and is not accordingly actually disclosed by Yamaguchi. Rather, Yamaguchi directly tracks the actions or presence of the users of the systems relative to any documents rather than the document itself in sharp contrast to the features recited in the pending claims. Therefore, if the examiner is to maintain this rejection, applicants respectfully request clarification as to where this claimed feature is disclosed in either Hecht or Yamaguchi.

Therefore, neither Hecht nor Yamaguchi nor their reasonable combination discloses or suggests at least this recited feature in independent claims 1 and 20. Accordingly, independent claims 1 and 20 are believed to patentable over the applied prior art.

#### Independent Claim 23

Independent claim 23 recites (1) receiving a voice input indicative of an annotation or processing instruction for the document, and (2) placing a mark on the hardcopy, the mark containing identification information and annotation or processing instructions for the document received from the voice input. As acknowledged in the Office Action, voice input is not disclosed by Hecht.

Instead the Office Action, relies on (1) Ruppert for disclosing the *claimed* voice input feature that recites placing a mark on a hardcopy indicative of both the identification information of the electronic document (corresponding to the hardcopy) and the annotation or processing instructions for the document based on the voice input, and (2) the data input 44 of Hecht for suggesting this combination with Ruppert. However, both of these assertions are incorrect for at least the following reasons.

*First*, Ruppert teaches input of voice commands for *operating* the copier having a common copier design. See, e.g., col. 4, lines 37-40 of Ruppert. Nowhere does Ruppert teach or suggest placing a mark on a hardcopy indicative of both the identification information of the electronic document (corresponding to the hardcopy) and the annotation or processing instructions for the document based on the voice input. At best, Ruppert teaches providing voice input indicative of common copier operations relative to a hardcopy processed or generated by the copier. That is, Ruppert does not teach or suggest feature (1) above.

*Second*, the Office Action then alleges that the data input 44 of Hecht provides the teaching for placing a mark on the hardcopy indicative of both the identification information of the electronic document and the annotation or processing instructions for the document based on the voice input. However, data input 44 relates largely to financial data input (coins, cards, debit, etc.) that is used to process a document whose identification information is presumably already provided separately to the controller 36 (for example, from a previously encoded glyph detected by the glyph detector 32 and decoded by the glyph decoder 34). That is, the data input 44 does not provide the input for placing a mark on the hardcopy indicative of both the identification information of the electronic document and the annotation or processing instructions. Therefore, even if Ruppert disclosed the claimed voice input feature (which it does not), there is no proper basis for combining Ruppert's voice input disclosure with the system disclosed by Hecht since data input 44 does not teach or suggest placing a mark indicative of both the identification information of the electronic document (corresponding to the hardcopy) and the annotation or processing instruction. That is, even combining Ruppert with Hecht does not disclose the features recited in claim 23.

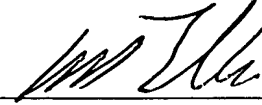
Therefore, neither Ruppert nor Hecht nor their reasonable combination disclose or suggest at least this recited feature of claim 23. Accordingly, claim 23 is believed to be patentable over the applied prior art.

#### Dependent Claims

The dependent claims are also allowable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

In view of the foregoing amendments and remarks, applicants believe that the application is in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local number below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. T. Ellis', is written over a horizontal line.

William T. Ellis  
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May 12, 2003  
Date